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In re Application of
PIENE et al.
Application No.: 09/831,553
Filing Date: 11 May 2001
Attorney's Docket No.: PIEN30001C/REF
For: PROCESS FOR PREPARING ORAL
CALCIUM COMPOSITIONS

DECISION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371 and applicant's petition under 37 CFR 1.181 filed in the United States Patent and Trademark Office on 27 December 2007.

BACKGROUND

On 05 November 1999, applicant filed international application PCT/GB99/03666, which claimed priority of an earlier British application filed 13 November 1998.

On 11 May 2001, applicant filed a transmittal letter requesting filing under 35 U.S.C. 371 in the United States which was accompanied by, *inter alia*, the basic national fee.

On 05 July 2001, a Notification of Missing Requirements was mailed to applicant, indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing after the thirty month period, was required. On 05 November 2001, applicant filed a response, including an executed declaration.

On 02 January 2002, a Notification of Acceptance was mailed to applicant.

DISCUSSION

On 11 May 2001, applicant submitted U.S. national application papers including a preliminary amendment to the specification indicating the following : "This application is a continuation-in-part of International Application No. PCT/GB99/03666 filed on November 5, 1999, which claims the benefit of GB 9825033.5 filed on November 13, 1998."

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111(a).

The Transmittal Letter (Form PTO-1390) filed on 11 May 2001 identified the application as "a filing under 35 U.S.C. 371." The preliminary amendment filed on the same date, amends the first line of the specification as follows: "This application is a continuation-in-Part of International Application No. PCT/GB99/03666...". The Transmittal Letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. The Office provides the TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 (FORM PTO-1390) so that applicant can comply with 37 CFR 1.495(g) and so that the Office's personnel can readily distinguish between submissions under 35 U.S.C. 371 and 35 U.S.C. 111(a). Applicant submitted the papers with the Transmittal Letter indicating that applicant was filing under 35 U.S.C. 371. The filing of the PTO-1390 is viewed by office personnel as a clear indication of papers submitted under 35 U.S.C. 371.

Nevertheless, applicant's reference to the papers as a continuation-in-part application in the preliminary amendment is inconsistent with the Transmittal Letter filed 11 May 2001 and contradicts the request in the Transmittal Letter to file under 35 U.S.C. 371. A national application which requests treatment as a continuation-in-part of an earlier international application cannot be considered the national stage application of that international application, and under the present circumstances, the statement amending the specification is an indication of papers filed under 35 U.S.C. 111(a).

In view of the above, it is proper to treat the initial filing as a filing under 35 U.S.C. 111(a). The declaration filed on 05 November 2001 and the preliminary amendment to the specification filed on 11 May 2001 met the requirements for granting a filing date for a filing under 35 U.S.C. 111(a). Accordingly, it is proper to accept the papers as a filing under 35 U.S.C. 111(a) with an filing date of 11 May 2001. The Notification of Acceptance under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 02 January 2002 is VACATED.

Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/831,553) and the international application (PCT/GB99/03666) designating the United States were copending on 11 May 2001.

CONCLUSION

The papers filed on 11 May 2001 will be treated as a U.S. application filed under 35 U.S.C. 111(a).

The Notification of Acceptance mailed on 02 January 2002 is hereby VACATED. The basic national fee of \$860 (fee code 970) and \$130 surcharge for filing the declaration after the thirty month period (fee code 154) will be refunded to applicant's deposit account,

This application is being forwarded to the International Division for removal of the papers communicated from the International Bureau to the United States of America. The application will then be forwarded to Office of Initial Patent Examination (OIPE) for processing as a regular national application under 35 U.S.C. 111(a) with a filing date of 11 May 2001.



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